

REMARKS/ARGUMENTS

This is in Response to the Non-final Office Action of February 9, 2007. Claims 1-12 and 17-20 remain in this application. Claims 13-16 have been cancelled. Reconsideration and allowance of the instant application are respectfully requested. No new matter is added.

Claims 1-12 are Allowable

Claims 1-12 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,555,768 and Naoyuki (JP 2000-200147). The rejection is respectfully traversed.

Claim 1 recites, among other features, a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

Applicants disagree with the Office Action characterization of the '768 Patent. In particular, the patent does not teach or suggest a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

The '768 Patent merely has contacts 8 and 9 which work on **depression** or a **depressing** the contacts. In effect, the patent is missing an element of the claim or clearly teaches away from the invention of claim 1. See the text below from the '768 Patent.

Two actuator contacts (8 and 9) are positioned below the roller member and depressing corresponding parts of the roller member activates either or both contacts.

It is an essential aspect of the present invention that the roller key in excess of the navigation possibilities in rolling or scrolling, provides switch signal outputs corresponding to at least four different logic states, as illustrated in Table 1 below. This is achieved by having at least two actuator contacts, which can be depressed individually or simultaneously by depressing corresponding parts of the roller member.

“768 Patent, Col. 5, lines 56-68

There is **no extension force** based sensing and the recited scrolling based on the sensing in this patent. Clearly, the discussion of depressing, “the essential aspects of the present invention of depressing parts” is teaching away from the invention of applicants. See *KSR Int’l v. Teleflex, Inc.*, 550 U.S. (2007), Slip Op. 04-1350 citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966) (“when the prior art teaches away from combining certain know elements, discovery of a successful means of combining them is more likely to nonobvious.”).

In addition, the figure pointed to in the Office Action does teach or suggest the recited features of the claim 1. Figure 1 below of the ‘768 Patent is reproduced below.

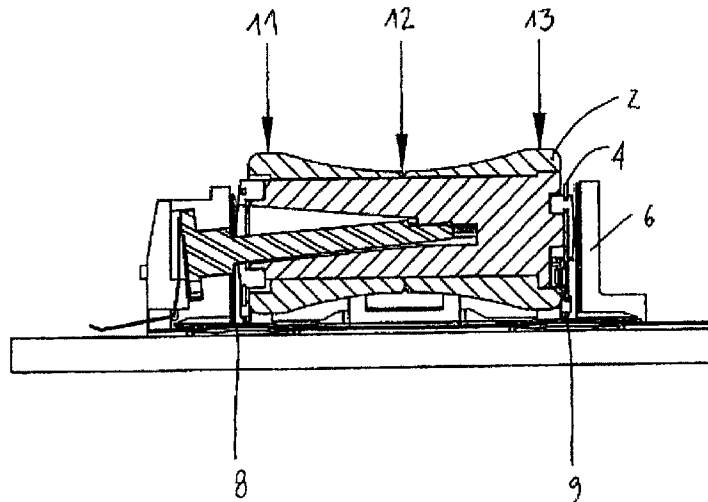


Fig. 1

As can be seen in FIG. 1 of the ‘768 Patent, it is devoid of **a sensor for detecting an extension force based on the pivotal movement of said rotatable member about the second axis** for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction. Indeed, the ‘768 Patent fails to teach or suggest an extension force at all.

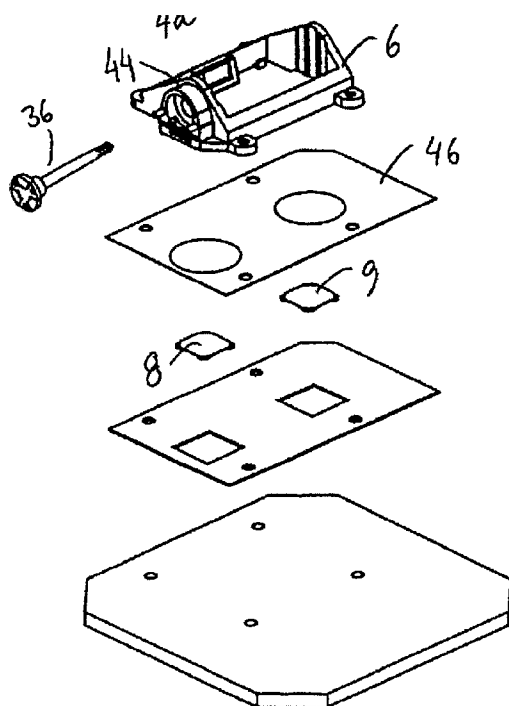


Fig. 3

As can be seen the portion of FIG. 3 reproduced above, sensor 8 and 9 on only can be depressed to work states in the patent. There is nothing about an extension force. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). Furthermore, functional limitations must be evaluated and considered, just like any other limitation of a claim. See MPEP § 2173.05(g).

Naoyuki merely discloses a scroll wheel and a stick but fails to teach or suggest scrolling an image in a second direction responsive to a detected extension force. Indeed, Naoyuki fails to teach or suggest an extension force at all. See *KSR Int'l v. Teleflex, Inc.*, 550 U.S. (2007), Slip Op. 04-1350 citing *United States v. Adams*, 383 U.S. 39, 51-52

(1966) (“when the prior art teaches away from combining certain know elements, discovery of a successful means of combining them is more likely to nonobvious.”).

It is respectfully asserted that motivation for combining Naoyuki with the ‘768 Patent is lacking. There is no teaching in the ‘768 Patent, nor any suggestion of scrolling an image in a left or right direction. The ‘768 Patent is completely silent as the scrolling in the left and right direction. Because the combination of the ‘768 Patent and Naoyuki fails to teach or suggest claim 1, it is respectfully submitted that claim 1 is allowable over the cited references.

Claims 2-8 depend from claim 1 and are allowable for at least the reasons set forth above for claim 1. Therefore, withdrawal of the rejection is respectfully requested.

Claim 9, recites among other features, sensing **one of a first tensile force** and a **second tensile force** based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force; and scrolling the image on the display screen in an approximately horizontal direction on the display screen, wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

The ‘768 Patent does not teach or suggest a **first tensile force** or a **second tensile force** based on the lateral pressure applied to the rotatable member, the second tensile force being greater than the first tensile force. Indeed, the ‘768 Patent fails to teach or suggest a **tensile force at all for scrolling**. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed limitation that was absent from the reference). Additionally, the ‘768 Patent and Naoyuki fails to teach or suggest the recited features of wherein the scrolling is at a first rate responsive to sensing the first tensile force and at a second rate responsive to sensing the second tensile force, the first rate being less than the second rate.

Claims 10-12 depend from claim 9. Therefore, it is respectfully submitted that the rejection of claims 9-12 should be withdrawn.

The Office Action has cited US Patent No. 6,075,518 to Pruchniak in combination with Naoyuki to reject claim 1, 2 and 4-12.

Claim 1 recites, among other features, a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

Applicants disagree with the Office Action characterization of the '518 Patent. In particular, the patent does not teach or suggest a sensor for detecting an **extension force** based on the pivotal movement of said rotatable member about the second axis for scrolling the image in a second scrolling direction perpendicular to the first scrolling direction, wherein the image is operable to scroll in the second direction responsive to the detected extension force.

The Office Action states that items 34, 36 are sensor which work on an extension force. (office Action, page. 8) These item are merely microswitches (see '518 patent, 3, lines 39). Clearly, one of ordinary skill would see these work on depressing, not an any extension force as asserted in the Office Action. The rejections should be withdrawn.

Claim 17-20 are Allowable

Claims 17-20 were allegedly rejected under 35 U.S.C. 103(a) under a combination of U.S. Patent No. 6,555,768 or Pruchniak, and Naoyuki (JP 2000-200147) and U.S. Patent No. 6,016,110. The rejection is respectfully traversed.

Regarding claim 17, as set forth above, the '768 Patent fails to teach or suggest various features. The '768 Patent or Pruchniak, either alone or in combination with Naoyuki, fails to teach or suggest claim 17. The '768 Patent also fails to teach or suggest a sensor positioned within said housing for sensing a period of time of lateral displacement of the rotatable member based on a tensile force or a signal to scroll the image across the display screen at a first speed if the period of time is less than or equal to a predetermined period of time, otherwise scrolling the image at a second speed, the second speed being greater than the first speed as recited in claim 17. For similar reasons

discussed above, there is no extension or tensile force detections for scrolling images in the 768 patent and Pruchniak.

There is no teaching in the '768 Patent, nor any suggestion of scrolling an image in a left or right direction. The '768 Patent is completely silent as the scrolling in the left and right direction. Claims 18-20 depend from claim 17 and are allowable for at least the reasons set forth above for claim 17.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date:

July 9, 2007

By:

A handwritten signature in dark ink, appearing to read "Darrell Mottley", written over a horizontal line.

Darrell G. Mottley
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